

## REMARKS

In accordance with the foregoing, claims 1, 3 and 6-17 are cancelled, claims 2, 4 and 5 are amended; thus claims 2, 4 and 5 are pending and under consideration.

### Rejections under 35 U.S.C. § 102

In the April 8, 2005 Office Action (hereafter "Office Action") spanning pages 2-4, claims 2, 4 and 5 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent 6,055,513 to Katz. These rejections are respectfully traversed.

The rejections of claims 2, 4 and 5 are not in compliance with 37 CFR § 104(a)(1) and the guidelines of MPEP 707.07(d). In particular, the Office Action has not established a case of *prima facie* unpatentability concerning claims 2, 4 and 5 and therefore, each of these claims is allowable. It is well settled that the "examination shall be complete with respect ... to compliance of the application ... with the applicable statutes and rules and to the patentability of the invention as claimed" (37 CFR § 104( a )( 1 )); it is also, well settled that the "Examiner should designate the *statutory* basis for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection" (MPEP 707.07( d )). In the Office Action, the rejections of claims 2, 4 and 5 are improperly expressed because page 2 of the Office Action identifies 35 U.S.C. § 102 as the statutory basis for the rejections, then in the body of the rejections, the claims are rejected on the basis of obviousness.

The Office Action rejected independent claim 2 on the basis of obviousness by alleging the limitation not shown by the applied art was well known in the art at the time of the invention, i.e., the Office Action attempted to rely on well known evidence to allege obviousness of the invention itself. It is well settled that "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based" citing *In re Zurko*, 258, F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)" (see MPEP 2144.03). In this case, the Office Action reached an unsubstantiated, ambiguous conclusion of obviousness by relying on impermissible hindsight and alleged well known evidence. If "well-known evidence" continues to be relied on to reject any of the claims, the Examiner is respectfully requested to either cite evidence supporting that the relied upon knowledge is actually well-known, or submit an Affidavit describing the knowledge of the Examiner, in accordance with MPEP § 2144.03

Furthermore, the Office Action cited FIG. 1 of Katz as showing "acquiring commodity-comparison information indicating at least one result of at least one comparison between said

commodities" (claim 2, lines 4-6). However, FIG. 1 of Katz discloses "COMPARE ORDER ENTRY DATA WITH ONE OR MORE DATABASE(s) TO DETERMINE 'UPSELL' DATA" (see element 12). The Office Action cites FIG. 2 of Katz as showing "storing in a storage device said commodity-comparison information acquired in ... (a)" (claim 2, lines 8-9). However, nothing can be found in FIG. 2 of Katz that teaches or suggests storing the "commodity-comparison information" limitation of claim 2. In addition, the Office Action cited FIG. 4 of Katz as showing "providing a comparison display" (Office Action, page 3, line 3). At this point, the Office Action ignored the wording of claim 2 and reached a conclusion of obviousness based on impermissible hindsight, in the admission that Katz "does not specifically state that the display is in a coordinate format" (Office Action, page 3, line 4).

Next, the Office Action relied on a statement of "well known" evidence in an attempt to provide the missing limitation admittedly not found in Katz of element (c) in claim 2 which originally was recited as

producing a commodity-comparison map which visually indicates at least one relationship between said commodities by using said commodity-comparison information stored in said storage device in such a manner that at least one coordinate axis of said commodity-comparison map corresponds to at least one first evaluation criterion used in evaluation of said commodities

(original claim 2, lines 10-16). Nothing has been cited or found in Katz that teaches or suggests producing a commodity-comparison map in the manner originally recited in claim 2. The Office Action cited item 148 in FIG. 4 of Katz as disclosing "producing relative-evaluation information which indicates at least one relative evaluation of said commodities by using said commodity-comparison map" (Office Action, page 3, lines 10-12). However, the block labeled 148 in the flowchart illustrated in Fig. 4 of Katz contains the legend "DISPLAY 'UPSELL' DATA ON CALLER'S PC AS AN ADDITIONAL OFFER". It is submitted that this does not teach or suggest the details recited on lines 10-16 of original claim 2.

Furthermore, nothing has been cited or found in Katz that teaches or suggests the limitations recited at lines 4-19 of amended claim 2. Claim 2 now recites comparing individual commodities based on a plurality of evaluation criteria and displaying relative superiority and inferiority relationships between commodities via a commodity-comparison map in a two-dimensional area with coordinate axes representing two specified evaluation criteria. Nothing has been cited or found in Katz that teaches or suggests each limitation of amended claim 2; thus, independent claim 2 is allowable for the reasons discussed above.

Finally, if there any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: Richard A. Gollhofer  
Richard A. Gollhofer  
Registration No. 31,106

1201 New York Ave, N.W., Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501